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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,062	01/04/2002	Stephen A. Milks	8416-000008	5754

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EXAMINER	
FREAY, CHARLES GRANT	

ART UNIT	PAPER NUMBER
3746	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/038,062	MILKS, STEPHEN A.	
	Examiner	Art Unit	
	Charles G. Freay	3746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5,7-11,13-16,18 and 19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5,7,8,10,11,13-16 and 19* is/are rejected.

7)☒ Claim(s) *9 and 18* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to the amendments and remarks of April 13, 2005. In making the below rejections the examiner has considered and addressed each of the applicant's arguments.

Drawings

After consideration of the applicant's remarks relating to one of ordinary skill understanding the concept of sealing electric motors the examiner has withdrawn the drawing objection. The examiner agrees with the applicant that one of ordinary skill in the art would understand how to provide a sealed casing for an electric motor.

Claim Objections

The cancellation of claim 6 has overcome the claim objection.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 5, 7, 8, 10, 13-16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raab et al in view of Fujisaki et al as set forth in the last office action (the action of January 13, 2005).

Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raab et al in view of Fujisaki et al as applied to claims 1 and 10 above, and further in view of Hung as set forth in the last office action.

Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raab et al.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Raab et al as applied to claim 10 above, and further in view of Hung as set forth in the last office action.

Allowable Subject Matter

Claims 9 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed April 13, 2005 have been fully considered but they are not persuasive. The applicant makes the following arguments: that Raab et al fails to disclose a rigid housing, that Fujisaki et al's motor is a miniaturized motor used for toys, stereos equipment, etc. instead of a low profile motor, that the examiner has used hindsight to determined obviousness, that there is no motivation in either of the

references to combine, that neither of the references discloses a sealed motor, and that Raab does not remotely speak of manually positioning the support members.

With regards to the applicant's first argument the examiner disagrees. Any electric motor casing which is supporting a fan structure, as shown in Raab et al, must be to some extent rigid. If the casing were non-rigid, as suggested by the applicant, the bearings, shafts, rotor and stators would become out of alignment during operation and would not operate properly. In either case, the applicant's argument is mute. In Raab et al the motor is generically disclosed as an "electric motor 15 for rotating the impeller" (col. 2 lines 21 and 22). One of ordinary skill in the art would understand upon reading this limitation that an electric motor must be used and would be prompted to search the prior art for an electric motor. Fujisaki et al clearly discloses a low profile electric motor having a rigid casing (note col. 2 lines 25-30). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicant's arguments that Fujisaki et al is miniaturized instead of low-profile the examiner disagrees. Low-profile refers to the "flatness" or the motor being small in thickness, in the applicant's case 1 inch. While Fujisaki et al discloses that the motor can be used in various small devices one of ordinary skill in the art would still find it clear upon reading Fujisaki et al that structure is directed to an electric motor designed to be small in size and at the same time provide a rotary drive output (see col. 1 lines

20-25). Further Fujisaki specifically discusses flatness. The applicant's arguments with relation to the size of the devices are essentially that the generically disclosed motor of Raab et al is slightly bigger than the applicant's motor and the motor of Fujisaki et al is a little bit to small. As shown in In re Rose, 105 USPQ 237, (CCPA 1955) changes in size of an element are generally not given patentable weight or would have been obvious improvements. One of ordinary skill in the art would have found it obvious to size the Fujisaki et al electric motor so that it could provide the correct driving force needed to drive an impeller.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case (and this part of the examiner's argument also has applicability to the hindsight argument) the Raab et al reference provides a clear suggestion to combine. It discloses a "black box" electric motor. One of ordinary skill who wants to build the Raab et al fan is given no further instruction by Raab et al than use an electric motor. Thus Raab et al not only suggest that one of ordinary skill consider an electric motor to be combined with his teachings it requires that one of ordinary skill consider any electric motors available for use to provide a rotary input.

With regards to the applicant's argument that neither of the references is sealed the examiner disagrees. As noted Raab et al is a generic teaching of an electric motor. It is noted that the applicant has provided no specific teaching of how his electric motor is to be sealed or a specific structure for doing so. Additionally, the applicant has admitted that one of ordinary skill in the art would understand how to provide a sealed motor. Fujisaki et al, as noted in the previous office action, discloses a tight and sealed casing around an electric motor and a shaft. The opening for the shaft is the only opening present. This tight and extended space between the shaft and bearing forms a labyrinth seal. With regards to the applicant's arguments that the Fujisaki et al motor is not sealed the examiner disagrees. The applicant's essentially has not disclosed how he's sealing his motor and the argument amounts to an "our motor is sealed and yours is not argument". To the degree that applicant has disclosed a sealed motor the Fujisaki et al device discloses a sealed motor.

With regards to the argument that Raab et al do not disclose manually positioning the support members the examiner agrees. However, the rejection set forth that it would have been obvious to make the positioning of the Raab et al support members manual. Such a modification would reduce parts and simplify the structure. The spring biased structure of Raab et al is certainly a convenient mechanism, however, one of ordinary skill would understand that by removing the spring a possible source of wear or malfunction would be removed and a more reliable mechanism would be created.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles G. Freay whose telephone number is 571-272-

4827. The examiner can normally be reached on Monday through Friday 8:30 A.M. to 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Thorpe can be reached on 571-272-4444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Charles G Freay
Primary Examiner
Art Unit 3746

CGF
May 28, 2005